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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/918,082	07/30/2001	Gregory Merle Pineo	60,680-531	2107

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EXAMINER

CIRIC, LJILJANA V

ART UNIT	PAPER NUMBER
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3743

DATE MAILED: 05/01/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/918,082

Applicant(s)

Pineo et al.

Examiner

Ljiljana V. Ciric

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on October 23, 2002 and Jan 30, 2003
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above, claim(s) 8-13, 19, and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 14-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on Nov 29, 2001 is: a) ☒ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some* c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 3
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Election/Restriction

1. Applicant's election of the first species corresponding to the embodiment of Figures 1 through 4 without traverse in Paper No. 8 is acknowledged.

Claims 1 through 7 and 14 through 18 are readable on the elected species.

Although claims 1 and 14 may be readable on all of the species, applicant's assertion that claims 1 and 14 are therefore generic is not persuasive since, while a generic claim must read on each of the species, the fact that a claim merely does so read is not conclusive that it is generic. For example, a generic claim cannot include limitations which are *not* present in *each* of the added species claims. See MPEP § 806.04(d).

2. Claims 8 through 13, 19, and 20 are hereby withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected , there being no allowable generic or linking claim. Election was made without traverse in Paper No. 8.

Priority

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Oath/Declaration

4. Receipt and entry of the substitute declaration is hereby acknowledged.

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Information Disclosure Statement

5. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered. In the instant application, the reference listed on page 1 of the specification has been considered by the examiner and has thus been cited on form PTO-892.

Drawings

6. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on November 29, 2001 have been approved. A proper drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The correction to the drawings will not be held in abeyance.

Claim Objections

7. Claims 4, 5, and 14 through 18 are objected to because of the following informalities: the number preceding each of claims 4, 14, and 18 is followed by a comma (,) instead of by a period. Appropriate correction is required.

Claim Rejections - 35 U.S.C. § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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9. Claims 1 through 7 and 14 through 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are written in a generally run-on fashion, and are thus rendered less readily readable and comprehensible.

With regard to claim 1 as written, for example, it is not readily obvious whether the limitations "including a plurality of parallel tubular members having adjacent wall portions defining flow openings in communication to form flow manifolds" in the preamble of the claim refer to the heat exchanger or to the bypass valve. It is also not clear with which elements the flow openings are in communication. With regard to the latter, claim 14 also contains an open-ended recitation of "in communication" in line 2 and is similarly rendered indefinite thereby, along with all claims depending therefrom.

Also with regard to claim 1 as written, it is not clear to which element or elements the indeterminate term "therein" in line 5 of the claim refers, thus rendering indefinite claim 1 and all claims depending therefrom. Claim 14 also contains a recitation of "therein" in line 5, and is similarly rendered indefinite thereby.

With regard to each of claims 7 and 16, it is not clear what particular meaning or structure corresponds to the limitations "wherein said side walls are spaced apart a predetermined distance so as to determine the spacing between adjacent heat exchanger tubular members," thereby rendering these claims indefinite with regard to the scope of protection sought.

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The above is an indicative, but not necessarily an exhaustive, list of 35 U.S.C. 112, second paragraph, problems. Applicant is therefore advised to carefully review all of the claims for additional problems. Correction is required of all of the 35 U.S.C. 112, second paragraph problems, whether or not these were particularly pointed out above.

Claim Rejections - 35 U.S.C. § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

NOTE: The above reflects changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002.

11. As best can be understood in view of the indefiniteness of the claims, claims 1 through 6, 14, 15, 17, and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by *Seiler et al.*

Seiler et al. discloses the invention essentially as claimed, including: a heat exchanger 12 having flow manifolds 16, 18, and 20; and, a bypass valve 14 or 44.

Seiler et al. [especially Figures 3 and 4] shows the bypass valve 14 or 44 as including, for example: a housing 46; a hollow plug portion corresponding to port 54 and associated structures,

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for example; inlet and outlet ports 56 and 58; an actuator portion corresponding to chamber 48; and, an actuator 64 which is a thermal motor [column 4, lines 28-34] releasably mounted in the actuator portion or chamber 48 and having a reciprocating plunger or central shaft 66 extending into the plug portion 54 to block and unblock flow between the outlets and inlets 56 and 58.

The reference thus reads on the claims.

12. The non-application of art against claims 7 and 16 should not be construed as an indication that the claims contain allowable subject matter but rather that the claims could not be examined on the merits due to indefiniteness.

Conclusion

13. The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Wilson, Ruf, Sommer, McIntosh, Marthaler, Woodhull, Jr., et al., and Wickham et al.
each discloses a plug and/or bypass valve in combination with a heat exchanger.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ljiljana (Lil) V. Ciric, whose telephone number is (703) 308-3925. While she works a flexible schedule that varies from day to day and from week to week, Examiner Ciric may generally be reached at the Office during the work week between the hours of 10 a.m. and 6 p.m. ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Bennett, can be reached on (703) 308-0101. The fax phone number is (703) 305-3463.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0861.

lvc

April 19, 2003



LJILJANA V. CIRIC
PRIMARY EXAMINER
ART UNIT 3743